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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,696	10/16/2001	Leon Hurst	017.40115X00	3758

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ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209-3873

EXAMINER

TRAN, PABLO N

ART UNIT	PAPER NUMBER
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2685

DATE MAILED: 10/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,696

Applicant(s)

HURST ET AL

Examiner

Pablo N. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 15-24 and 38-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 25-37 and 48-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01/03/02, 05/21/03.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3, 6, 8, 10, 13, 27, 29, 31, 33, 36, 50, 52, 54, 56, and 59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 3, 6, 8, 10, 13, 27, 29, 31, 33, 36, 50, 52, 54, 56, and 59, the claimed limitation "customizing the features of the content based on prestored profile information indicating the capabilities and functions of said second terminal" render the claim indefinite. When storing content, the content will be stored based upon the second terminal user's prestored profile or the content will be stored based upon the second terminal capabilities and function. The examiner will interpret as the content will be stored based upon the second terminal capabilities and function and examined as such.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-14, 25-37, 48-61 are rejected under 35 U.S.C. 102(e) as being anticipated by Tagawa et al. (EP1081616).

As per claims 1, 25, 48, and 61, Tagawa et al. disclosed a superdistribution in a telecommunications network having a plurality of terminals, for permitting a first user of a first terminal to distribute contents stored in said first terminal to a second user of a second terminal to permit said second user to inspect and purchase said content if desired, said superdistribution method comprising the steps of: transmitting said content from said first terminal to said second terminal; receiving said content in said second terminal; temporarily storing said content in said second terminal in a manner to permit said content to be inspected by said second user; permitting said second user to inspect said content; permitting said second user to purchase said content if desired and automatically discarding said content if not desired; and permanently storing said content in said second terminal when purchased by said second user (abstract, [0038-0041], [158-159])

As per claims 2, 26, 49, Tagawa et al. disclosed the claimed invention ([0038]).

As per claims 3, 6, 8, 10, 13, 27, 29, 31, 33, 36, 50, 52, 54, 56, and 59, Tagawa et al. does not explicitly disclosed such the content will be stored based upon the second terminal capabilities and function ([0038-0041], [158-159], where it is clear the

content can be customized to stored based upon the remaining space in the memory card).

As per claim 4, Tagawa et al. disclosed the claimed invention ([0038-0041], [158-159]).

As per claims 5, 28, and 51, Tagawa et al. disclosed the claimed invention ([0038-0041], [158-159]).

As per claims 7, 30, and 53, Tagawa et al. disclosed the claimed invention ([0038-0041], [158-159]).

As per claims 9, 32, and 55, Tagawa et al. disclosed the claimed invention ([0038-0041], [158-159]).

As per claims 11, 34, and 57, Tagawa et al. disclosed the claimed invention ([0038-0041], [158-159]).

As per claims 12, 35, and 58, Tagawa et al. disclosed the claimed invention ([0038-0041], [158-159]).

As per claims 14, 37, and 60, Tagawa et al. disclosed the claimed invention ([0038-0041], [158-159]).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sehr (2001/0018660), Yasukawa et al. (5,999,622), and Auerbach et al. (5,673,316) disclose distribution of data in a radiotelephone communication system.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo Tran whose telephone number is (571)272-7898. The examiner normal hours are 9:30 -5:00 (Monday-Friday). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (571)272-7899.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

October 3, 2005

**PABLO N. TRAN
PRIMARY EXAMINER**

